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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,648	03/07/2001	Stacey J. Swart	10004942-1	3330

7590 07/01/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/800,648

Applicant(s)

SWART ET AL.

Examiner

Doug Hutton

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 7, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claims 6 and 15:***

Claims 6 and 15 contain the trademark/trade name Adobe® FrameMaker + SGML. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an SGML authoring tool and, accordingly, the identification/description is indefinite.

For purposes of examination, the examiner will assume that the "technical writing tool algorithm is simply an SGML authoring tool.

*Claims 7 and 16:*

Claims 7 and 16 contain the trademark/trade name WebWorks® Publisher Professional. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a conversion tool for converting a document from an SGML format to an HTML format and, accordingly, the identification/description is indefinite.

For purposes of examination, the examiner will assume that the "technical writing tool algorithm is simply a conversion tool for converting a document from an SGML format to an HTML format.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Motoyama et al., U.S. Patent No. 6,009,436.

*Claim 1:*

Motoyama discloses an apparatus for generating files (see Figures 1-20; see  
Column 1, Line 1 through Column 40, Line 15), the apparatus comprising:

- a first logic configured to perform a technical writing tool algorithm, the technical writing tool algorithm for receiving input describing a particular selected format and content for a document, the technical writing tool algorithm for processing said input to generate a first markup language file, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information (the mapping system discloses each of these elements in that it includes text files written to generate SGML documents; thus, the mapping system "receives input" and "processes the input" to generate an SGML file; this SGML file is the "first markup language file" and includes "first markup language formatting information;" the SGML file instructs a computer how to format the document on a printer so that the SGML document can be "printable as a hardcopy document"); and

- a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file, wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document (the mapping system discloses each of these elements in that it receives the SGML file, performs an SGML to HTML mapping and outputs the resulting HTML file; this HTML file is the "second markup language file;" the HTML file includes formatting information that describes how to format the HTML document for online viewing).

*Claim 2:*

Motoyama discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the first markup language file is printed (as specified in the above rejection for Claim 1, the SGML file instructs a computer how to format the document on a printer so that the SGML document can be formatted for hardcopy output; thus, the mapping system includes "style information" for printing the SGML document).

*Claim 3:*

Motoyama discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document

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elements are to have if the second markup language file is placed on-line (as specified in the above rejection for Claim 1, the HTML file includes formatting information that describes how to format the HTML document for online viewing).

*Claim 4:*

Motoyama discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML).

*Claim 5:*

Motoyama discloses the apparatus of Claim 1, wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the second markup language is HTML).

*Claim 6:*

Motoyama discloses the apparatus of Claim 1, wherein said technical writing tool algorithm is an SGML authoring tool (as specified in the above rejection for Claim 1, Motoyama discloses the creation of SGML documents).

*Claim 7:*

Motoyama discloses the apparatus of Claim 1, wherein said conversion algorithm is used for converting a document from an SGML format to an HTML format (as



specified in the above rejection for Claim 1, Motoyama converts the SGML documents into HTML documents).

*Claim 8:*

Motoyama discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

*Claim 9:*

Motoyama discloses the apparatus of Claim 8, wherein said first logic is pre-configured to map styles native to said technical writing tool algorithm to styles native to said conversion algorithm, and wherein said first markup language formatting information includes information relating to said styles native to said conversion algorithm (the mapping system discloses "first logic that is pre-configured to map styles native to said technical writing tool algorithm to styles native to said conversion algorithm" in that it permits the user to map SGML elements to the corresponding HTML elements; the mapping system discloses "first markup language formatting information that includes information relating to said styles native to said conversion algorithm" in that the SGML formatting information is "related" to the "styles of the conversion algorithm" through the mapping).

*Claims 10-18:*

These claims merely recite the method performed by the apparatus of Claims 1-9, respectively. Thus, Motoyama discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 1-9.

*Claim 19:*

Motoyama discloses the method of Claim 18, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

*Claim 20:*

This claim merely recites computer software that performs the same method performed by the apparatus of Claim 1. Thus, Motoyama discloses every limitation of this claim using the same rationale discussed in the above rejection for Claim 1.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by [www.adobe.com/products/framemaker/sgmlwhatsnew.html](http://www.adobe.com/products/framemaker/sgmlwhatsnew.html) (hereinafter, Adobe) as it appeared on 15 August 2000. This web page is archived at <http://web.archive.org/web/20000815094608/http://www.adobe.com/products/framemaker/sgmlwhatsnew.html>.

*Claim 1:*

Adobe discloses an apparatus for generating files (see Pages 1-2; see also the printed source file for this web page), the apparatus comprising:

- a first logic configured to perform a technical writing tool algorithm, the technical writing tool algorithm for receiving input describing a particular selected format and content for a document, the technical writing tool algorithm for processing said input to generate a first markup language file, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information (Adobe discloses each of these elements in that it discloses FrameMaker+SGML 6.0, which is a popular tool used to assemble documents in both hardcopy print and electronic form; FrameMaker+SGML supports the creation of SGML documents); and
- a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file, wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document (Adobe discloses each of these elements in that it discloses WebWorks Publisher for use with FrameMaker+SGML; WebWorks converts the SGML documents created in FrameMaker+SGML into HTML documents for publishing content on the World Wide Web).

*Claim 2:*

Adobe discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the first markup language file is printed (Adobe discloses each of these elements in that FrameMaker+SGML allows the user to create an SGML document that has "style information" that instructs a computer how to format the document on a printer).

*Claim 3:*

Adobe discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the second markup language file is placed on-line (Adobe discloses each of these elements in that WebWorks converts the SGML document into an HTML document that has "style information" that instructs a computer how to present the HTML document online).

*Claim 4:*

Adobe discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML).

*Claim 5:*

Adobe discloses the apparatus of Claim 1, wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the second markup language is HTML).

*Claim 6:*

Adobe discloses the apparatus of Claim 1, wherein said technical writing tool algorithm is an SGML authoring tool (as specified in the above rejection for Claim 1, FrameMaker+SGML supports the creation of SGML documents).

*Claim 7:*

Adobe discloses the apparatus of Claim 1, wherein said conversion algorithm is used for converting a document from an SGML format to an HTML format (as specified in the above rejection for Claim 1, WebWorks converts the SGML documents created in FrameMaker+SGML into HTML documents).

*Claim 8:*

Adobe discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

*Claim 9:*

Adobe discloses the apparatus of Claim 8, wherein said first logic is pre-configured to map styles native to said technical writing tool algorithm to styles native to said conversion algorithm, and wherein said first markup language formatting information includes information relating to said styles native to said conversion algorithm (Adobe discloses each of these limitations in that it discloses that FrameMaker+SGML 6.0 includes WebWorks Publisher).

*Claims 10-18:*

These claims merely recite the method performed by the apparatus of Claims 1-9, respectively. Thus, Adobe discloses every limitation of these claims using the same rationale discussed in the above rejections for Claims 1-9.

*Claim 19:*

Adobe discloses the method of Claim 18, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

*Claim 20:*

This claim merely recites computer software that performs the same method performed by the apparatus of Claim 1. Thus, Adobe discloses every limitation of this claim using the same rationale discussed in the above rejection for Claim 1.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Motoyama et al., U.S. Patent No. 6,085,196; Fong et al., U.S. Patent No. 6,279,015; DeRose et al., U.S. Patent No. 6,546,406; Hon et al., U.S. Patent No. 6,185,608; DeRose et al., U.S. Patent No. 5,893,109; Huang, U.S. Patent Application Publication No. US 2001/0032218 A1; [www.quadralay.com/products/wwpp\\_fm/default.aspx](http://www.quadralay.com/products/wwpp_fm/default.aspx) as it appeared on 25 June 2004; Holzschlag, Molly E., Special Edition Using HTML 4, Sixth Edition, Chapter 3 – “*HTML Tools*” (Que Publishing, 21 December 1999); and Morrison, Michael, *XML Unleashed*, Chapter 26 – “*XML Authoring and Content Management Tools*” (Sams Publishing, 21 December 1999).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone

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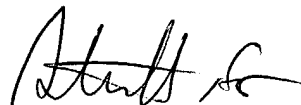
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number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH

June 25, 2004



**HEATHER HERNDON  
SUPERVISORY PATENT EXAMINER  
TECH CENTER 2100**